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IN THE
Supreme Court of the United States

October Term, 1940

No. 666

DETROLA RADIO & TELEVISION CORPORATION,
Petitioner,

vs.

HAZELTINE CORPORATION,
Respondent.

REPLY BRIEF FOR PETITIONER.

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Consistent with the practice adopted in our main brief, we will herein refer to petitioner as "Detrola", and to respondent as "Hazeltime".

We will likewise adhere to the order of argument followed in our main brief, and reply to such of Hazeltime's contentions as warrant comment, under the four specific "points" of argument therein enumerated.

Before taking up the specific "points" of argument, however, a few comments of a general nature are necessitated by various assertions made in the introductory portion of Hazeltime's brief (pp. 1-16, inclusive).

1. At the outset (pp. 1 and 2), the Hazeltime brief again endeavors to induce this Court to refrain from passing on the merits of the cause by framing in its own language, and in its own order, the questions presented to this Court for decision, and then asserting that there is no conflict of opinion in lower courts on any of those questions.

It is believed that this case has passed that stage of contention, because, in granting a writ of certiorari, this Court was quite properly convinced that there is here presented a direct conflict between the Second and Sixth Circuit Courts of Appeals, as well as impelling and publicly important questions relative to improper use of the reissue statute—as set forth as the “reasons” for the grant of the writ relied upon in the petition therefor.

In consequence, it is believed that Hazeltine's efforts in this respect are futile, because even the specific questions as framed by the Hazeltine brief are based upon and flow directly from the situation created by the conflicting opinions of the Second and Sixth Circuit Courts of Appeals, as well as the improper use of the reissue statute which the record in this case evidences.

Because of its unwarranted insistence that there is no conflict of opinions, and in the effort to disguise its sole function in the radio industry of exacting an onerous tribute as a price for peace from expensive and harassing litigation, Hazeltine finds it necessary to characterize Detrola's statement of the case as “imperfect” in three enumerated respects. These are (brief, pp. 3-5):

(1) That it is “not true” that Hazeltine's sole business is to acquire and own patent rights under which it grants licenses. In support of this assertion the brief recites other things that Hazeltine does *for its licensees*. But it is not and cannot be denied (in view of Finding 12 of the District Court, II, 843, which was agreed to by counsel) that *Hazeltine's sole revenues are the royalties it collects from the licensees under its patents*. From this it is evident that it is the fact that Hazeltine's sole business is to acquire and own patent rights under which it grants licenses. Without its patents, Hazeltine has no licenses. Without its licenses, Hazeltine has no business.

(2) It is again asserted that it is "not true" that the Second Circuit Court of Appeals in the *Abrams* case held the original Wheeler patent to be invalid for want of disclosure of a patentable invention. The reason for Hazeltine's desperate persistence in this assertion is made evident by Point III of Detrola's main brief (pp. 32-51), and Hazeltine's expressed recognition (later in its brief) that there is neither logic nor authority to support the validity of the Wheeler reissue patent if the Second Circuit Court of Appeals did so hold. A mere reading of Judge HAND's opinion for the Second Circuit Court of Appeals will settle the question. We are content to rest the matter there.

(3) It is charged that there is an improper "implication" in paragraph 3 of Detrola's statement of the case, to the effect, as stated by the Hazeltine brief, that the "Patent Office in granting the reissue was unaware of and did not take into account the adverse decisions on the original patent in the Second Circuit". This is purely imaginary, possibly added to the alleged imperfections of Detrola's statement of the case, to supply, by length, what the first two paragraphs lack in substance. It is plainly stated in paragraph 3 of Detrola's statement, that the application for the reissue patent in suit was filed on September 26, 1934 "without *then* calling to the attention of the Patent Office the adverse decisions the patent had received in the Eastern District of New York";* *and the file wrapper citation given therefor (viz., III, pp. 998 et seq.) shows this to be an undeniable fact.* Moreover, Detrola's main brief (on pp. 39-41) points out, at length and in detail, that the adverse decisions of the New York Courts were *ultimately* called to the atten-

* Emphasis in quotations in this brief is ours unless otherwise stated.

tion of the Patent Office Examiner, and the manner in which that was done.

It is submitted from the foregoing, therefore, that Hazeltine's attempt to attach to Detrola the stigma of "imperfect" or incorrect statement of the underlying facts of the case is as unwarranted as it is futile.

2. The introductory portion of Hazeltine's brief initiates—by careful choice of terminology repetitiously adhered to thereafter—a deliberate effort to induce and accustom this Court to think that the alleged invention of the Wheeler reissue patent consists of automatic *volume* control, as distinguished from automatic *amplification* control. Upon its success in this effort Hazeltine's brief later predicates its entire hope of escaping the completely anticipatory effect of the prior Heising and Slepian patents. It is our present purpose merely to illuminate this effort, here where it first evidences itself, with the light of the simple indisputable fact that Wheeler's reissue patent itself—*both in its specifications and in its claims*—defines the invention purported to be disclosed thereby as automatic *amplification* control, and not *volume* control (III, 869, 872; see also our main brief p. 13).

POINT I.

The Wheeler patent is invalid (Hazeltine brief pp. 39-73).

Apparently fearful of the consequences of considering the question of validity of the subject matter of the Wheeler patent, Hazeltine starts this section of its brief with a final plea to this Court to refrain from passing on this subject. The brief then proceeds to try to confine a consideration

of "the disclosure of the patent" to automatic *volume* control, as distinguished from automatic *amplification* control. The discussion leads to the quotation, in blackface type (on p. 43) of "*the main feature of the invention*" as contained on page 2 of the patent; second column, beginning at line 12 (III, 870). This quotation is of sufficient interest and importance to reproduce here:

"In accordance with the main feature of the present invention the degree of amplification effected in the radio-frequency amplifying stages is automatically controlled by a biasing potential obtained by rectifying the modulated signal carrier in a two-electrode rectifier 33, having a resistance 51 connected between the filament 38 and the anode 35 of the rectifier, through which the pulsating rectified or converted current flows, thereby developing a negative voltage at terminal 52."

This quotation is interesting from two aspects.

In the first place, it will be noted that it is "*the degree of amplification*" that is controlled—not of *volume*. This language is consistent with the specifications and claims of the patent, and wholly inconsistent with Hazeltine's persistent effort to inject other terminology.

In the next place, this "*main feature of the invention*" consists merely of a diode rectifier, united with a resistance, the output of the diode rectifier being connected to the grid of a radio frequency amplifier to control the biasing potential thereon. *But this is precisely what is shown by numerous instances of the prior art.* In consequence, it was necessary for Hazeltine to find *something* in the disclosure of the original Wheeler patent—no matter how small or trivial it might be—that could be advanced in a *reissue* as different from the prior art so as to enable Hazeltine to assert—as it here does—that is what Wheeler invented. Unfortunately,

however, there was nothing in the original Wheeler disclosure which would serve the purpose, and it became necessary, therefore, to seize upon one of the old elements in this old combination, and dress it up in some way, in the hope it would get by. The element seized upon is "the resistance 51 connected between the filament 38 and the anode 35 of the rectifier". This resistance is now characterized as "high" in value. We ask—*how high*; or high relative to what? *The patent does not tell us.*

Realizing this fatal deficiency of *anything* in the disclosure of the patent on which to base support for its present theory, the Hazeltine brief *now* attempts to supply that information (e. g. pp. 52, 61) as "*high in relation to the internal resistance of the diode*". There is not the slightest basis in the patent, either by statement or implication, for any such thing.

The brief then asserts that, as a result of the use of "high" resistance, "linear rectification" is obtained. *That*, then, is what is suggested as Wheeler's contribution which differentiates it from the prior art, and which warranted a reissue for failure to claim that *precise* thing as the invention of the *original* patent.

The utter want of merit in the suggestion is established by each of the following facts:

- (1) In the first place, there was no novelty in linear rectification with a diode. The prior patent to Armstrong, No. 1,716,573 (III, 1306), shows that it was well known to use a diode with a high external resistance to obtain linear response for whatever purpose it might be desired. This patent (p. 2, line 121) describes the resistance as "large", and (on p. 3, line 22) gives its value as from 100,000 to 200,000 ohms (see Kelley's discussion of this patent—I, 236-239).

- (2) In the next place, there was nothing novel even in using a diode linear detector in an automatic amplification control circuit. Precisely that is shown in the prior Heising patent (III, 1272). If, as Hazeltine asserts, the mere use of a "high" resistance with a diode causes the diode to give linear rectification, then the diode of Heising inevitably effects linear rectification because his resistance 12, connected between the electrodes of the diode, is specifically described and claimed by Heising in Wheeler's own language, namely as a "high" resistance (see p. 3, line 39; see also claim 6).
- (3) Moreover, whether a detector gives linear response or non-linear response is a mere matter of choice. It involves no circuitual change whatever; and this is true with respect to both diode and triode detectors. All that is involved is giving proper values to the electrical instrumentalities included in the circuit. *This was admitted by Hazeltine's expert (I, 489-490).*
- (4) Furthermore, the use of a "high" resistance was nowhere mentioned in the original Wheeler specification throughout its prosecution in the Patent Office; nor was it mentioned in the specifications of the original patent as issued. The first time the term appeared in the case was in claim 11 which was presented by an amendment dated August 18, 1932—after the application had been allowed—*five years after the original application for patent had been filed on July 7, 1927.* It will likewise be noted that *this was three years after the issuance of the Armstrong patent, and four years after the issuance of the Heising patent.*
- (5) Also, it will be evident (as pointed out in our main brief pp. 31-32), that this first injection of "high" re-

sistance into the Wheeler patent was made only after the advent of the screened grid tube made it possible for diode automatic amplification control to be commercially practical for home radio receivers where cost is a controlling factor.

- (6) In addition, it is conclusively evident that the designation of "a diode united with a high resistance" was never really considered by Wheeler to constitute his invention. Rather, it is the invention of Hazeltine's counsel. This is made apparent not only by the fact that a "high" resistance was not injected into the original Wheeler application (by claim 11) until five years after the original application for patent was filed (as above pointed out), but also by the fact that when Wheeler published his invention in the Proceedings of the Institute of Radio Engineers *not the slightest mention was made thereof* (III, 984-8; see also Hazeltine's brief p. 64).

- (7) Finally, the assertion that the failure to claim "a diode united with a high resistance" in the original patent was the underlying and a proper reason for applying for a reissue thereof becomes utterly preposterous in the face of the fact that that subject matter *was* claimed (by claim 11) in the original patent, and was considered to be so trivial and unimportant that this claim was not even asserted in either of the New York litigations.

It is evident, therefore, that there is nothing novel in the Wheeler disclosure, and there is no proper distinction between the original and reissue patents.

Hazeltine's Discussion of the Evans Patents (brief pp. 48-52).

About the only things which Hazeltine advances to meet the anticipatory effect of the Evans patents, as established in our main brief (pp. 15-21, inclusive), are quotations from the wholly erroneous decisions of the courts below. Apparently, Hazeltine has no answer to the seven enumerated, established and controlling instances of error that were specifically pointed out on pages 20 and 21 of our main brief.

Hazeltine's Discussion of the Affel and Friis Patents (brief pp. 53-55).

Hazeltine's brief presents nothing with respect to these patents which has not already been covered in our main brief (pp. 22 and 24). We must comment, however, upon Hazeltine's charge (footnote p. 71) that Detrola has indulged in "reckless assertion" with respect to the use by the Western Electric Company of the a.a.c. system of the Friis patent. The charge is directed to the statement (on p. 24 of our main brief) that Friis obtained linear rectification, whereas it is asserted by Hazeltine that he testified "that he did not get a linear effect", citing II, 668, XQ172. This cited testimony was based on a strict, literal definition of "linear response" as is made perfectly apparent by the previous testimony of Mr. Friis (XQ171, II, 665; and XQs. 147-149, p. 661). From this testimony it will be seen that Mr. Friis stated that he did "not quite" obtain rectilinear response (see XQ147). *Neither did Wheeler*. In Wheeler's publication of his invention before the Institute of Radio Engineers in January 1928 (III, 986, 987), all that he had to say about the subject was that he obtained "nearly linear proportionality". It is self evident, therefore, that

Friis *did* obtain linear rectification—as was stated in our main brief—in the same sense and to the same extent that *Wheeler did*, and, consequently, in the same sense and to the same extent that the term is used or intended to be interpreted in the Wheeler patent. Moreover, as made clear by Hazeltime's expert (I, 422), the test of whether or not linear rectification is obtained, is whether or not distortion is present, and Mr. Friis expressly testified (II, 664, XQ163)—

“We used circuits like that (the Friis circuit) for more than a year and we did not notice distortion” (explanatory matter in parentheses ours).

Hazeltime's Discussion of the Heising and Slepian Patents (brief pp. 55, 56).

As stated in our main brief (pp. 21 and 25), each of these patents constitutes a complete anticipation of the Wheeler claims. Moreover, they disclose, element for element, what the patent and the Hazeltime brief (p. 43) characterize as “the main feature” of the Wheeler invention, as we shall now show. Literally applying that language from the patent to both Heising and Slepian, we find that

“the degree of amplification effected in the radio-frequency amplifying stages (the radio frequency amplifiers 5 of Heising, and 1 of Slepian) is automatically controlled by a biasing potential (applied to the grid electrodes of the amplifying tubes in both Heising and Slepian) obtained by rectifying the modulated signal carrier in a two-electrode rectifier 33 (the two-electrode rectifier 11 in Heising, and 18 in Slepian) having a resistance 51 connected between the filament 38 and the anode 35 of the rectifier (the resistance 12 in Heising, and the resistance 9 of Slepian; each of these resistances is connected be-

tween the filament and the anode of the rectifier) * *through which the pulsating rectified or converted current flows (true in both Heising and Slepian), thereby developing a negative voltage at terminal 52 (developing a negative voltage at the circuit terminal leading to the grid electrode of the radio frequency amplifier in both Heising and Slepian)."*

With such complete identity in structure, circuit arrangement and operation—regardless of for what purpose the automatic amplification control is effected—what remains to support validity for the Wheeler patent over these prior references? In our opinion nothing remains, and apparently our opinion is concurred in by Hazeltine, because the only material way in which Hazeltine attempts to meet the situation is to *misstate* what was said on the subject in Detrola's main brief, and then to characterize the *misstatement* as untrue.

Thus, Hazeltine says (brief, p. 55):

"Petitioner says with respect to Heising (brief, pp. 21-2) and with respect to Slepian (brief, p. 25) that respondent's expert testified that both Heising and Slepian disclose automatic *volume* control. This is not the fact and the references to the record cited by petitioner do not support petitioner's statement."

No such statement was made in petitioner's brief. What was stated in petitioner's brief was that both Heising and Slepian disclose automatic amplification control—the thing described and claimed by the Wheeler patent—and that Hazeltine's expert, Dr. Hazeltine, expressly admitted that

* The resistance 9 of Slepian is not "connected between" the filament and anode of the rectifier. On the contrary, the inductance 16 is interposed between the resistance and the anode of the rectifier. In this respect the Slepian disclosure is identical with the Detrola a.c. circuit, as pointed out in our main brief (p. 30). Therefore, if the Detrola receiver infringes despite this difference, the Slepian patent of necessity anticipates.

to be the fact. Because our veracity has thus been challenged, even in this distorted manner, we quote the testimony. First, with respect to the Heising patent, the testimony of Hazeltine's expert is as follows (I, 491):

"Q. Will you turn to Heising patent. Is the function of the two-electrode device in Heising to regulate the amplification of the three-electrode amplifier? A. Yes, as a stepping stone to achieving the purposes of the invention.

Q. And does the two-electrode device in Heising accomplish that automatically? A. Yes."

Similarly, with respect to the Slepian patent, the testimony of Hazeltine's expert is (I, 490):

"Q. Does the action of the diode tube 18 alter or regulate the negative bias on the grid of the amplifier? A. It regulates the negative potential on the grid of the amplifier. That negative potential is not most usually called a bias. The word 'bias' is usually used to mean a potential which remains fixed during the reception of the signal.

Q. Slepian calls it a bias, doesn't he? I direct your attention to column 2 of the first page beginning of line 109? A. Yes, I find that he does, but my statement is correct that that is not generally called a bias, and I think not very accurately called a bias.

Q. Well, whether it is called a bias or what it is called, the device is used for increasing the negative charge on the grid condenser 8, is that right? A. For intermittently increasing it?

Q. Yes. A. Not continuously.

Q. Yes. Now, does the Slepian arrangement accomplish that automatically? A. Yes."

From the foregoing it will again be seen how desperate is the effort, and how extreme and unwarranted the expedient adopted, to avoid these complete anticipations of

what is shown, described and *claimed* as the invention of the Wheeler patent.

After discussion of the prior art, the Hazeltine brief (beginning at page 56 and extending to page 73) is devoted to a stereotyped "build-up" of the alleged invention of "a diode united with a high resistance". This practice is usually indulged in only when, as here, complete anticipation of the precise thing patented is found in the prior art.

Thus, the hours of fruitless labor of the inventor in his struggle to achieve success is alluded to, and Wheeler's notebook records of his experiments are described (p. 58) as constituting

"a revealing and interesting record of a series of schemes planned, investigated and rejected by Wheeler before he arrived at his final system".

And, later, that—

"Wheeler alone of all those who worked on the problem progressed beyond these proposals to the final simple form."

We are amazed at these assertions in view of the indisputable evidence in this case—most of it from Hazeltine's own witnesses.

The extent of Wheeler's alleged *investigation* consisted of making a few wiring diagrams in a notebook in July 1925, while on his summer vacation from school, and, during his Christmas vacation, drawing a few more pictures and building one home radio receiver which did not work (I, 93), but which, nevertheless, he patented (as Patent No. 1,879,862; I, 488; III, 1361); and this patent is included among those held by Hazeltine as a threat over the industry. Thus, Wheeler testified (I, 77-8) that until Christmas 1925 he "had been too busy on other things to construct any apparatus". Therefore, it will be seen that Wheeler's al-

leged "revealing and interesting record" of investigation comprised nothing more than a few sporadic notebook entries and one lone experiment.

In view of the foregoing, we wonder what constitutes a "rejected" scheme. Of course, what is implied as having been rejected, presumably as no good, is the use of a triode detector in automatic amplification control circuits. But *Wheeler* never rejected them, or attempted to, until after the decision of the Court of Appeals for the Second Circuit. His original patent showed, described and covered triode a.a.c. The reissue patent in suit still covers triode a.a.c. (claims 2, 3, 6, 9). Moreover, as we have shown (our main brief pp. 20-21), *Wheeler* still has two additional patents, the disclosures of which are confined to triode a.a.c. *Neither of these patents has ever been disclaimed* (I, 500, 501).

Likewise, though diode a.a.c. was available to *Hazeltine's* licensees, the commercial sets first produced utilized triode a.a.c., and not diode a.a.c.

How can it be said with any degree of sincerity (even to meet the exigencies of this case) that *Wheeler* "alone" progressed to the final simple form of diode a.a.c. *when Heising and Slepian specifically disclosed it in their prior patents, and Evans suggested it as a matter of common understanding?*

Surely, the fact that *Hazeltine's* own licensees utilized triode a.a.c. in lieu of diode a.a.c., which was at the same time available to them at no additional royalty expense, was occasioned by something more substantial than want of knowledge on the part of the skilled engineers of the art, as *Hazeltine's* brief implies. To what could it be attributed? Mr. Kelley made it perfectly clear (I, 228-229), that until sufficient amplification was procurable by improvement in the vacuum tube amplifier construction, to use diode a.a.c. necessitated so many amplifying tubes (and

their necessary adjunctive equipment) in order to give sufficient input to the rectifier, that the cost of the receivers was prohibitive. This is conclusively shown by the fact that the first, and then the only, radio receiver marketed by a Hazeltine licensee (The Howard Radio Company of Chicago) which employed diode a.a.c.

"was priced at several thousand dollars and only six of them were ever built" (Hazeltine brief p. 64).*

Furthermore, it was expressly admitted on cross examination by a number of engineers from these licensee companies who were called by plaintiff (Graham, II, 526; Cotter, II, 555; Johnston, II, 565-567; Curtis, II, 579; Farrand, II, 602; also see MacDonald, II, 635, and Wheeler, II, 161, 166, 167-8). It is obvious, therefore, that the utilization of a diode rather than a triode in an a.a.c. circuit owed nothing to Wheeler. Its extensive use was due solely to the improvements in the three-electrode vacuum tube art which, by the advent of the screened grid tube, made greater amplification possible, and thereby enabled the industry to eliminate the extra battery which the use of a diode made possible.

The foregoing simple, logical facts cannot be explained away by an alleged "prejudice" against the diode detector on the part of the radio industry (brief p. 66). Such "prejudice" has been created by the fertile imagination of Hazeltine's counsel, with no evidence in the case or in fact to support it.

Likewise, it is no answer to the issues in this case for Hazeltine to select the work of a number of workers in the art who were making inventions in the same or associated fields, and then to state that *they* did not attempt to patent diode a.a.c. (brief p. 68). Hazeltine need not have stopped where it did in its brief. Undoubtedly, hundreds of

* Wheeler testified (I, 132) that the Howard receiver was "reputed to have sold at \$3,000.00 or so".

additional names of engineers working in the field of radio could have been included in the list. We fail to see, however, how that meets the simple fact that Heising, Slepian and Evans *did* do so prior to Wheeler. Nor does the fact that other prior art patents relating to varying *specific* types of automatic amplification control (hand picked by Hazeltine for the purpose) did not show diode a.a.c., establish in any sense that those same patentees did not have full *knowledge* of diode a.a.c. A fitting illustration of that possibility will be found with Wheeler alone. Surely, the fact that he had two patents issued to him (1,879,861 and 1,879,862—see our main brief p. 20) for automatic volume control in which a *triode* rectifier *alone* was shown and described, would not be evidence that Wheeler had not known of diode a.a.c. Hazeltine's case must, indeed, be considered desperate to resort to such an argument.

It is believed that it has been conclusively shown that the Wheeler reissue patent discloses no trace of novelty or invention, and is wholly invalid because thereof.

POINT II.

The Wheeler reissue patent is not infringed (Hazeltine brief pp. 73-76).

As pointed out in our main brief (pp. 25-31), the Detroit receivers charged to infringe do not employ a "rejector" circuit which, both experts agreed, is "*absolutely essential*" and "*necessary*" to be employed by Wheeler because of the particular automatic amplification control circuit he proposed. This rejector circuit, in turn, necessitates that the "high" resistance element be directly "connected between" the electrodes of the tube. This necessary specific element, or feature, is *expressly* included in the Wheeler claims.

Because it does *not* use the Wheeler automatic amplification control circuit, the Detrola receiver has no rejector circuit. In consequence, its external diode resistance is *not* "connected between" the electrodes of the diode. Therefore, the Detrola receivers do *not* utilize an *essential* and *necessary* element and feature *claimed* by the Wheeler patent.

Apparently because Hazeltine has no other answer to this simple proposition, its brief seeks to wave it aside (p. 75), as "details of electrical connection determined by quite trivial considerations." We believe that the *fact* of elimination, by an alleged infringer, of an "absolutely essential" and "necessary" feature of a patent, as well as the *legal effect* of the inclusion of that feature in the patent claim may not be so lightly waved aside. Detrola does not use the *claimed invention* of the Wheeler patent, and therefore does not infringe it.

POINT III.

The Wheeler reissue patent has been improvidently granted (Hazeltine brief pp. 17-39).

A. The Invalidity of the original patent because it did not disclose a patentable invention can not be cured by reissue (Hazeltine brief pp. 17-28).

Hazeltine's argument on this subject resolves itself into the assertion that there are two types of reissue cases, each separately supported by authority, comprising—(1) that type where the original patent has been declared to be invalid for failure to disclose a patentable invention: in which case no valid reissue may be obtained; and (2) that type involving a patent, which *does* disclose a patentable invention (and so held by the Court), but some *specific*

claims thereof, for some technical or other reason, have been declared to be invalid by the Court: in which case a valid reissue may be obtained.

Thereupon, the brief devotes its further discussion of the subject to the effort to show that the present case is one of the second type. Hazeltine's effort to do this is confined to the mere repetitious assertion that the present case is of the second type. Of course, that is a matter which can and must be determined by reading the opinion of the Second Circuit Court of Appeals invalidating the original patent in the *Abrams* case (79 Fed. [2d] 329). A mere reading of that opinion (or the pertinent excerpts therefrom on p. 14 of our main brief) indisputably shows that the Second Circuit Court of Appeals held that the original patent disclosed no invention whatever.

Though it is a matter of minor importance, we might here correct the erroneous statement in the second footnote of Hazeltine's brief (p. 18) that the First Circuit Court of Appeals reversed the District Court in the case of *Erickson v. Frink Co.* "on the very point in issue". This is not the fact, as an examination of the decision of the Court of Appeals will show (20 Fed. [2d] 407).

B. The reissue patent was improvidently granted by the Patent Office because no facts were presented with the application therefor from which it could have been determined that "inadvertence, accident or mistake" occurred in the procurement of the original patent (Hazeltine brief pp. 28-33).

Hazeltine's sole answer to the statement of fact of this heading is a statement directly to the contrary; namely, that Wheeler *did* set forth in his reissue application oath facts which constituted "inadvertence, accident or mistake".

This raises a simple issue of fact that warrants no further argument on our part. The issue can be completely and effectively resolved by this Court merely by reviewing the sentence-by-sentence analysis of the oath, contained on pages 39-41 inclusive of our main brief (which is in no respect criticized by Hazeltine); or by reading the Wheeler oath in its entirety (III, 1051-2; 1102-6). It will then be seen that the statement of the heading is correct (Cf. *Union Switch & Signal Co. v. Louisville Frog, Switch & Signal Co.*, 73 Fed. [2d] 550); *Firestone Tire & Rubber Co. v. United States Rubber Co.*, 79 Fed. [2d] 941).

C. The reissue patent was improvidently granted by the Patent Office because the oath accompanying the application for reissue affirmatively establishes that no "inadvertence, accident or mistake" occurred in connection with the original patent, and the only material averments were false (Hazeltine brief pp. 33-34).

The point of the law presented in our main brief under this heading (pp. 43-48), is simple and dispositive. Hazeltine's brief in no respect meets it. It is quite true that counsel for Detrols do not and never have charged counsel for Hazeltine with dishonesty, fraud, or deception, and, for that reason, quite readily participated in framing and agreeing to Finding 19 of the District Court (II, 844-945). But that fact does not meet the point here involved, namely, that the reissue oath affirmatively shows that no "inadvertence, accident or mistake" occurred in the procurement of the original patent. The only reason advanced for the reissue is precisely the one which has been judicially held not to constitute inadvertence, accident or mistake (*Heidbrink v. Hardissen*, 25 Fed. [2d] 8).

Moreover, the fact that Judge GALSTON's opinion was called to the attention of the Patent Office Examiner at *some time* during the prosecution of the application for re-issue, affords no justification whatever for the assertion that the application for the reissue was *occasioned* by Judge GALSTON's opinion, when, for over a year after that opinion, the claims invalidated thereby were not amended in the slightest respect, and during that time an appeal from Judge GALSTON's decree was being vigorously prosecuted in the Court of Appeals.

D. The reissue patent is invalid because of laches in applying for it (Hazeltime brief pp. 34-39).

Here, again, Hazeltime fails to meet the issue presented. Even though it may be true that Hazeltime and the patentee were unfamiliar with the invalidating prior art patents until they were pleaded in the answer in the *Abrams* case in May, 1934 (Hazeltime's brief, p. 10), it cannot be denied that this invalidating art *was* called to the attention of Hazeltime and the patentee *at that time*. Therefore, the law imposed upon Hazeltime and the patentee the obligation to disclaim from the patent its invalid subject matter without unreasonable delay after such knowledge, or to stand their ground and suffer the consequences if they were wrong in so doing. They elected to stand their ground; and under that election they prosecuted their unsuccessful appeal to the Second Circuit Court of Appeals. Indeed, they could have gone further—they could have petitioned this Court, or could have prosecuted their original patent against another defendant in *another* jurisdiction, as is so vigorously claimed in the Hazeltime brief (p. 35). *But they did none of these things*. To the contrary, they reissued their patent on the statement to the Patent Office—under oath, as required by the reissue statute—that the patent was “inoperative or

invalid", while at the same time they were vigorously asserting that the patent was operative and was valid in the particular respects which subsequently became the basis of the reissue because of alleged "inadvertence, accident or mistake" in the procurement of the original patent. Thus, the sole question is whether or not, after notice of the invalidity of the original patent, Hazeltine unreasonably delayed in making application for the disclaiming reissue. With the invalidating prior art concededly called to Hazeltine's attention in May, 1934; and Judge GALSTON's invalidating opinion rendered on August 6, 1934; and no corrective amendment filed until September 4, 1935 (III, 1077, 1102), it is obvious that Hazeltine has been guilty of unreasonable and inexcusable delay. Therefore, the Wheeler reissue patent is invalid on that ground.

POINT IV.

Detrola has intervening rights (Hazeltine brief pp. 76-78).

Hazeltine bases its contentions on this point of argument on its own interpretation of what is meant by a "broadening" reissue, and asserts that the doctrine of this Court in the *Sontag* case (310 U. S. 281) applies only to a "broadening" reissue as Hazeltine interprets the term. We see no justification for Hazeltine's position in this respect. We believe that the term "broadening", as used in its normal sense, and as used by this Court in the *Sontag* case, means including within the scope of the claims of a reissue patent, an instrumentality which would not be included within the claims of the original patent. That, of course (as made perfectly clear by the decision in the *Sontag* case), is the legal test in determining whether or not intervening rights exist. That, alone, is the test that is here invoked.

The Detrola automatic amplification control circuit is identical in every material respect with the Colonial circuit held by Judge CAMPBELL in the *R. E. B.* case (8 Fed. Supp. 100) *not* to infringe the original patent. Also, Hazeltine's brief expressly admits (pp. 77-78)

"that the manufacture of the accused type of receiving sets by petitioner began and was renewed *before* the original Wheeler patent issued in September 1932 (emphasis Hazeltine's)."

Therefore, on these undisputed facts, every essential element of the doctrine of intervening rights is present. In consequence, it is wholly immaterial whether the reissue-patent be termed a "broadening" patent or a "narrowing" patent. The simple and controlling fact is that the claims of the *reissue* patent are asserted to be infringed by an automatic amplification control circuit which has been judicially held *not* to infringe the claims of the *original* patent; and Detrola's manufacture of a radio receiver employing that circuit concededly began, not only *prior to the application for the reissue patent*, but prior to the issuance of the original patent as well. (Of *Fox Typewriter Co. v. Corona Typewriter Co.*, 282 Fed. 502, 506.) Therefore, Detrola has intervening rights which may not be vitiated by the Wheeler reissue patent.

Conclusion.

***The judgment of the Sixth Circuit Court of Appeals
should be reversed.***

Respectfully submitted,

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